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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/092,084	03/06/2002	James E. Rediske	Mo6986/MD-00-34A-LS	8530
157	7590	06/07/2004	EXAMINER YOON, TAE H	
BAYER POLYMERS LLC 100 BAYER ROAD PITTSBURGH, PA 15205			ART UNIT	PAPER NUMBER

1714

DATE MAILED: 06/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/092,084

Applicant(s)

REDISKE ET AL.

Examiner

Tae H Yoon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 20-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-19 and 23-26 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

The table 2 on page 12 is objected since it contains a separated word (STANDA + RD).

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-19 and 22-26, drawn to a stabilized composition, classified in class 524, subclass 432+.
- II. Claims 20-22, drawn to a process of mixing, classified in class 523, subclass 351+.

The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product can be made by wet methods such as adding a pigment and ZnO during polymerization.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, and the search required for Group II is not required for Group I, restriction for examination purposes as indicated is proper.

During a telephone conversation with Mr. Gil on June 1, 2004 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-19 and 22-26. Affirmation of this election must be made by applicant in replying to this Office action. Claims 20-22 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

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Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-19 and 23-26 are provisionally rejected under the judicially created doctrine of double patenting over claims 1-19 and 23-26 of copending Application No. 10/091,749. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: the instantly recited stabilization under 750kj UV radiation would encompass the recited stabilization under 1500kj UV radiation of said copending application, or the recited stabilization under 750kj UV radiation having ΔE of 50% of the instant invention

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would meet the recited stabilization under 1500kj UV radiation having ΔE of at least 10% of said copending application, for example.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 19 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Improper Markush language is recited and insertion of "consisting" between "group" and "of" in line 2 is needed.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

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such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7, 10-12, 18, 19 and 23-26 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Nagaoka et al (US 5,478,878).

Nagaoka et al teach a light-stabilized polymeric composition containing inorganic fillers such as zinc oxide and an organic dye or pigment in abstract. Amount of said inorganic fillers and organic dye or pigment encompassing the instant amount are taught at col. 3, lines 21-42. Examples of Nagaoka et al show the use of aluminum flake and titanium oxide, but the examiner cites *In re Mills*, 477 F2d 649, 176 USPQ 196 (CCPA 1972); Reference must be considered for all that it discloses and must not be limited to preferred embodiments or working examples. Also, choosing zinc oxide from the disclosed several inorganic filler would not require much effort and thus is anticipation. The instantly recited physical properties would be inherent in composition of Nagaoka et al, and applicant has a burden to show otherwise since applicant has used a particular testing method. The recited pigments of claim 19 are optional components when claim 19 is combined with claim 18.

Thus, the instant invention lacks novelty.

Claims 1-16, 18, 19 and 23-26 are rejected under 35 U.S.C. 103(a) as obvious over Nagaoka et al (US 5,478,878) alone, or in view of WO 96/09348.

The instant invention further recites particle sizes of ZnO and red and violet pigments over Nagaoka et al. However, Nagaoka et al teach particle sizes of about 0.5 micron (500 nm) or lower at col. 3, line 28 and titanium oxide having a particle size of 18 nm at col. 7, line 59. Nagaoka et al further teach that filler having smaller particle size gives better discoloration

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resistance at col. 3, lines 15-16. Thus, the use of ZnO having the instant particle sizes would be obvious practices. Also, Nagaoka et al teach various organic dyes and pigments such as pigment yellow and pigment orange, and thus the use of pigment red or pigment violet would be obvious design choice.

With respect to claims 7-9, Nagaoka et al teach the amount of inorganic filler being preferably about 3 to about 20 parts at col. 3, lines 21-23, and thus the utilization other amount as claimed would be obvious (*In re Mills*) absent any criticality.

WO teaches light stabilized polymer containing ZnO having the instant particle size in abstract.

It would have been obvious to one skilled in the art at the time of invention to utilize ZnO having the instant particle size in Nagaoka et al with or without teaching of WO since Nagaoka et al teach that a filler having smaller particle size gives better discoloration resistance, or to utilize pigment red or pigment violet in Nagaoka et al since Nagaoka et al teach employing various pigment colors depending on the desired color absent showing otherwise.

Claims 1, 2, 17, 18 and 23 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Brown et al (US 4,898,762).

Brown et al teach the instant composition comprising polypropylene, ZnO and pigment such as TiO₂ and iron oxide in example 1 (col. 5, lines 56-62).

The instantly recited physical properties would be inherent in the composition of Brown et al. Thus, the instant invention lacks novelty.

Claims 1, 6-9, 17, 18 and 23 are rejected under 35 U.S.C. 103(a) as obvious over Brown et al (US 4,898,762).

The instant invention further recites ratios of ZnO and a pigment and an amount thereof in a composition over Brown et al. However, Brown et al teach blending 2 parts of tan pigment concentrate (45% pigments and 55% polypropylene) and 100 parts of polypropylene in example 1. Thus, the amount of pigment is about 0.88% based on the total components. Thus, an equal amount of the recited five pigments would be about 0.176%, for example.

It would have been obvious to one skilled in the art at the time of invention to utilize the instantly recited amount of ZnO in said example 1 since one would know employing various amounts of pigments in order to obtain said tan pigment concentrate.

Claims 1-19 and 23-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 96/09348 in view of Nagaoka et al (US 5,478,878) and Brown et al (US 4,898,762), and further in view of JP (Kokai) 2-208369 and Deanin et al (UV-stabilization of PP by zinc oxide, Modern Plastic, Jan. 1969).

WO teaches a polymeric composition comprising polyethylene and zinc oxide having particle diameters of 10-200 nm in abstract.

The instant invention further recites employing a pigment or a dye and amounts thereof over WO. However, the utilization of pigments in a polymeric composition having zinc oxide is well known as taught by Nagaoka et al and Brown et al. JP and Deanin et al teach that zinc oxide is the well known UV stabilizer.


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It would have been obvious to one skilled in the art at the time of invention to utilize the instantly recited amount of a pigment and ZnO in WO with teaching of Nagaoka et al and Brown et al since the utilization of pigments in a polymeric composition is a routine practice in the art and since the utilization of various amounts of additives (pigment and ZnO) would be considered a common practice and since JP and Deanin et al teach that zinc oxide taught by WO is the well known UV stabilizer.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tae H Yoon whose telephone number is (571) 272-1128. The examiner can normally be reached on Mon-Thu.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Tae H Yoon
Primary Examiner
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THY/June 2, 2004